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EXAMINER

COLILLA, DANIEL JAMES

ART UNIT PAPER NUMBER

2854

DATE MAILED: 08/29/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/829,619

Applicant(s)

TESLER, JOSEPH

Examiner

Dan Colilla

Art Unit

2854

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 June 2003 and 12 June 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) 13-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 and 21-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 April 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. The amendment to the specification has not been entered because it is not in proper form. Specifically, for the paragraph regarding related applications, a clean copy paragraph is required. With respect to the remaining amendment to the specification, replacement sheets are not permitted, replacement paragraphs are required.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over the Dei'ah veDibur article in view of Graham.

With respect to claims 1 and 6, the Dei'ah veDibur article discloses the claimed method except it is not known if the letters of the text are placed on the parchment with a single movement of a human hand. The Dei'ah veDibur article discloses that it is known to reproduce Jewish religious scrolls known as *megillas* on parchment paper using a silk screening method (see paragraphs 2-3 of the article). The specific details of the silk screen process are not mentioned in the article. However, Graham teaches that it is known to perform silk screening by drawing a squeegee over a stencil in one direction (Graham, col. 1, lines 30-35). It would have been obvious to combine the teaching of Graham with the method of silk screening disclosed by

the Dei'ah veDibur article for the highly detailed precision that is afforded by moving the squeegee in only one direction. The determination of whether the resulting scroll is Kosher or not appears to be a subjective one as is noted by the differing perspectives in the present application and the Dei'ah veDibur article. With respect to applicant's recitation requiring no defects in the scroll, it is noted (as pointed out in applicant's disclosure of the prior art) that it is known to take measures preventing defects in the religious scroll.

With respect to claims 2-5, there does not appear to be any unobviousness in the selection of content for the document being printed. It would be obvious to print whatever text that is desired to be communicated.

4. Claims 7-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dei'ah veDibur in view of Graham as applied to claims 1-6 above, and further in view of Churchwell.

With respect to claim 7, Dei'ah veDibur in view of Graham discloses the claimed method for preparing a Jewish religious scroll except for the step of providing an ultraviolet ink. However, Churchwell teaches that it is known in silk screening processes to use an ultraviolet ink (page 1, paragraph 0005). It would have been obvious to combine the teaching of Churchwell with the method disclosed by Dei'ah veDibur in view of Graham for the quick curing advantages of ultraviolet of ink.

With respect to claim 8, Churchwell further teaches that it is known to use water-based inks in silk screening (page 1, paragraph 0006). A water based ink is heat sensitive since as the water evaporates from the ink due to application of heat, the ink will dry.

5. Claims 8-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dei'ah veDibur in view of Graham as applied to claims 1-6 above, and further in view of Dunson.

With respect to claim 8, Dei'ah veDibur in view of Graham discloses the claimed method for preparing a Jewish religious scroll except that it is not known if the ink is heat sensitive. However, Dunson teaches that it is known to use heat sensitive ink in silk screening. In col. 4, lines 17-24, Dunson discloses that the ink is cured by bank of lamps 14. It would have been obvious to combine the teaching of Dunson with the method disclosed by Dei'ah veDibur in view of Graham for the advantage of the safety device for reducing scorch of the substrate being printed (Dunson, col. 3, lines 47-49).

With respect to claims 9-10, since the curing device taught by Dunson is a bank of lamps, it would illuminate the substrate while it is being dried.

6. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dei'ah veDibur in view of Graham as applied to claims 1-6 above, and further in view of Hackett.

Dei'ah veDibur in view of Graham discloses the claimed method, except that it is not known if the content being reproduced is based on a pre-existing document. However, it is well-known in the silk screening art that reproducing an original image by use of a silk screen (Hackett, pg. 1, paragraph 0004). It would have been obvious to combine the teaching of Hackett with the method disclosed by Dei'ah veDibur in view of Graham for the advantage of creating copies of popular works. As mentioned above, there appears to be no unobviousness in the selection of the particular work that is being reproduced.

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7. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dei'ah veDibur in view of Graham as applied to claims 1-6 above, and further in view of Libby.

Dei'ah veDibur in view of Graham discloses the claimed method except for etching grid lines into the parchment. However, Libby teaches that it is known to emboss a grid pattern in a writing media (Libby, col. 2, lines 40-48). It would have been obvious to combine the teaching of Libby with the method disclosed by Dei'ah veDibur in view of Graham for the advantage of using the embossed lines for aiding in layout and alignment of text or images on the media.

8. Claims 1-6 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over applicant's disclosure of the prior art in view of Erickson.

With respect to claim 1, applicant's admission of prior art discloses the claimed method except for the automated placement of text with a single movement of the human hand. In applicant's disclosure of the prior art, as outlined in pgs. 4-6, applicant discloses that the requirements for preparing a Jewish religious scroll are known. These requirements include placing text of a Jewish religious scroll onto kosher parchment by hand so that the scroll does not have any defects in each letter and each letter is separated. Erickson teaches a method for automatically placing text 6 onto a substrate 7 with a squeegee 5 as shown in Figure 3 of Erickson. Additionally, Erickson teaches that the squeegee is used to draw the ink across the screen cloth 2 so that the ink will pass through the open areas of the text 6 leaving a print on the workpiece 7 (Erickson, col. 3, lines 44-30). It would have been obvious to combine the teaching of Erickson with applicant's admission of prior art for the advantage of automating the placement of text on a substrate and therefore reducing the time it takes to hand write a

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document. Furthermore, it would have been obvious to one of ordinary skill in the art to print the text with no defects according to the required level of quality.

With respect to claims 2-5, applicant's admission of prior art discloses that it is known to print a Torah scroll, a Megillah scroll, a Mezzuzah scroll and a Tefillin scroll. It would have been obvious to one of ordinary skill in the art to screen print and desired document in view of the teaching of Erickson.

With respect to claim 6, Erickson teaches a silk screen template 2.

With respect to claim 27, on page 5, lines 10-11, of applicant's disclosure, applicant discloses that crowns on the printed letters are known.

9. Claims 7-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over applicant's admission of prior art in view of Erickson, as applied to claims 1-6 above, and further in view of Churchwell.

With respect to claim 7, applicant's admission of prior art in view of Erickson discloses the claimed method for preparing a Jewish religious scroll except for the step of providing an ultraviolet ink. However, Churchwell teaches that it is known in silk screening processes to use an ultraviolet ink (page 1, paragraph 0005). It would have been obvious to combine the teaching of Churchwell with the method disclosed by applicant's admission of prior art in view of Erickson for the quick curing advantages of ultraviolet of ink.

With respect to claim 8, Churchwell further teaches that it is known to use water-based inks in silk screening (page 1, paragraph 0006). A water based ink is heat sensitive since as the water evaporates from the ink due to application of heat, the ink will dry.

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10. Claims 8-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over applicant's admission of prior art in view of Erickson, as applied to claims 1-6 above, and further in view of Dunson.

With respect to claim 8, applicant's admission of prior art in view of Erickson discloses the claimed method for preparing a Jewish religious scroll except that it is not known if the ink is heat sensitive. However, Dunson teaches that it is known to use heat sensitive ink in silk screening. In col. 4, lines 17-24, Dunson discloses that the ink is cured by bank of lamps 14. It would have been obvious to combine the teaching of Dunson with the method disclosed by applicant's admission of prior art in view of Erickson for the advantage of the safety device for reducing scorch of the substrate being printed (Dunson, col. 3, lines 47-49).

11. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over applicant's admission of prior art in view of Erickson, as applied to claims 1-6 above, and further in view of Hackett.

Applicant's admission of prior art in view of Erickson, discloses the claimed method, except that it is not known if the content being reproduced is based on a pre-existing document. However, it is well-known in the silk screening art that reproducing an original image by use of a silk screen (Hackett, pg. 1, paragraph 0004). It would have been obvious to combine the teaching of Hackett with the method disclosed by applicant's admission of prior art in view of Erickson, for the advantage of creating copies of popular works. As mentioned above, there appears to be no unobviousness in the selection of the particular work that is being reproduced.

12. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over applicant's admission of prior art in view of Erickson, as applied to claims 1-6 above, and further in view of Libby.

Applicant's admission of prior art in view of Erickson, discloses the claimed method except for etching grid lines into the parchment. However, Libby teaches that it is known to emboss a grid pattern in a writing media (Libby, col. 2, lines 40-48). It would have been obvious to combine the teaching of Libby with the method disclosed by applicant's admission of prior art in view of Erickson, for the advantage of using the embossed lines for aiding in layout and alignment of text or images on the media.

13. Claims 21-22, 26 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over applicant's disclosure of the prior art in view of Erickson.

With respect to claim 21, applicant's admission of prior art discloses the claimed method except for the automated placement of text with a single movement of the human hand. In applicant's disclosure of the prior art, as outlined in pgs. 4-6, applicant discloses that the requirements for preparing a Jewish religious scroll are known. These requirements include placing text of a Jewish religious scroll onto kosher parchment by hand so that the scroll does not have any defects in each letter and such that no letters touch another letter on the document. Additionally, applicant discloses on pg. 4, lines 5-6 that it is known to place *sirtut* (horizontal guidelines) on a scroll when printing a Kosher religious text. Erickson teaches a method for automatically placing text 6 onto a substrate 7 with a squeegee 5 as shown in Figure 3 of

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Erickson. Additionally, Erickson teaches that the squeegee is used to draw the ink across the silk screen cloth 2 so that the ink will pass through the open areas of the text 6 leaving a print on the workpiece 7 (Erickson, col. 3, lines 44-30). It would have been obvious to combine the teaching of Erickson with applicant's admission of prior art for the advantage of automating the placement of text on a substrate and therefore reducing the time it takes to hand write a document. Furthermore, it would have been obvious to one of ordinary skill in the art to print the text with no defects according to the required level of quality.

With respect to claims 22 and 28, on page 5, lines 10-11, of applicant's disclosure, applicant discloses that crowns on the printed letters are known.

With respect to claims 26, the first full paragraph on page 6 of applicant's specification discloses that reciting a blessing and imprinting the name "G-d" has long been a known tradition. *It appears that when using the term "G-d" applicant intends to mean that the actual term being printed in the religious scroll includes an "o" between the "G" and "d" rather than a "-". As the examiner understands it, the term with the "o" is not permitted except when using the name in a religious scroll or prayer and the term "G-d" is used at all other times.*

14. Claims 23-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over applicant's admission of prior art in view of Erickson, as applied to claims 1-6 and 27 above, and further in view of Churchwell.

With respect to claim 23, applicant's admission of prior art in view of Erickson discloses the claimed method for preparing a Jewish religious scroll except for the step of providing an ultraviolet ink. However, Churchwell teaches that it is known in silk screening processes to use

an ultraviolet ink (page 1, paragraph 0005). It would have been obvious to combine the teaching of Churchwell with the method disclosed by applicant's admission of prior art in view of Erickson for the quick curing advantages of ultraviolet of ink.

With respect to claim 24, Churchwell further teaches that it is known to use water-based inks in silk screening (page 1, paragraph 0006). A water based ink is heat sensitive since as the water evaporates from the ink due to application of heat, the ink will dry.

With respect to claim 25, Churchwell teaches ink as mentioned above, and on page 5, lines 10-11, of applicant's disclosure, applicant discloses that crowns on the printed letters are known.

Response to Arguments

15. Applicant's arguments filed 6/2/03 have been fully considered but they are not persuasive of any error in the above rejection.

Applicant has successfully petitioned to obtain a priority date of February 23, 2000. However, the teaching of Dei'ah veDibur article is still considered as prior art. Although Dei'ah veDibur has a publishing date of March 8, 2000, the article indicates that the information included in the article was known previously. Applicant's attention is invited to paragraphs 2-3 of the Dei'ah veDibur article. At the beginning of paragraph 2, Dei'ah veDibur recites, "In recent weeks a letter. . . was circulated." The article continues with, "dishonest people have recently been distributing *megillas* on parchment in our city." Paragraph three begins with "two weeks ago" someone had been selling silk screened *megillas*. This indicates that the process was known at least two weeks before March 8, 2000 which was February 23, 2000. Finally, in the seventh paragraph, the article states that, the man purchased a large amount of parchment, prepared

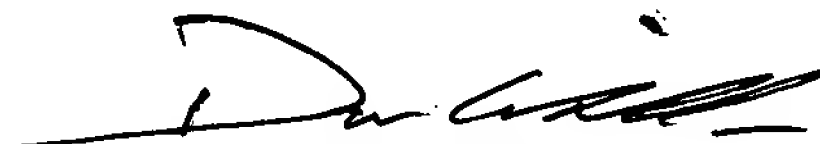
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printing blocks of the *megillas*. . . and found a printer. . . who took the job.” Such a large undertaking must have taken more than 24 hours and thus the method must have been known before February 23, 2000.

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dan Colilla whose telephone number is (703) 308-2259. The examiner can normally be reached M-F, 8:30-5:30. Faxes regarding this application can be sent to (703) 746-4405.

If attempts to reach the examiner by telephone are unsuccessful, the examiner’s supervisor, Andrew Hirshfeld can be reached at (703)305-6619. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

August 21, 2003



Dan Colilla
Primary Examiner
Art Unit 2854